

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte IVAN J. BAIGES

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Appeal No. 2005-1273  
Application No. 10/057,619

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ON BRIEF

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Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 19 and 21 to 44, which are all of the claims pending in this application.

We REVERSE and REMAND.

### BACKGROUND

The appellant's invention relates generally to inkjet printing devices. In particular, the appellant's invention is an inkjet printing system having multiple printheads for depositing ink droplets onto print media to form images and text on different areas of the print media at the same time. The use of multiple printheads printing at the same time on different portions of the print media results in greatly increased print media throughput for the inkjet printing system (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Logan	4,910,871	Mar. 27, 1990
Asakawa	4,940,998	July 10, 1990
Granzow	5,677,719	Oct. 14, 1997
Chapin et al. (Chapin)	5,838,343	Nov. 17, 1998
Yashima et al. (Yashima)	6,164,747	Dec. 26, 2000

Claims 1 to 6, 8 to 14, 18, 19, 21 to 28, 30 to 33 and 35 to 44 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yashima in view of Granzow.<sup>1</sup>

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<sup>1</sup>Claim 44 was not included in the statement of this rejection. However, it is clear from the rejection that the examiner meant to include claim 44 in this ground of rejection.

Claims 7 and 34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yashima in view of Granzow and Logan.

Claims 15 to 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yashima in view of Granzow and Asakawa.

Claim 29 stands rejected under 35 U.S.C. § 103 as being unpatentable over Yashima in view of Granzow and Chapin.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed November 1, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed October 5, 2004) and reply brief (filed December 20, 2004) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the

examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 19 and 21 to 44 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In the rejection of the independent claims on appeal (i.e., claims 1, 19, 30 and 44), the examiner (answer, pp. 4-10) concluded that it would have been obvious for a person of ordinary skill in the art at the time of the invention to have modified the Figure 10 embodiment of Yashima so as to position an unprinted print medium (e.g., a blank sheet of paper) so that the first movable printhead assembly (head 31A of Yashima, see Figure 10) and the second movable printhead assembly (head 31B of Yashima, see Figure 10) deposit ink only on the first and the second portions respectively without

depositing ink on other portions as suggested by Granzow. The examiner states that the motivation for doing so would have been to achieve faster printing speed as taught by Granzow (column 5, lines 12-22).

The appellant argues in the brief and the reply brief that modifying Yashima in the manner suggested by the examiner would preclude the recording heads of the Yashima from performing two-pass recording and printing a plurality of inks of different densities in superposition on the same pixel, thereby defeating a "characterizing feature" of Yashima and rendering Yashima unsatisfactory for its intended purpose. Because modifying Yashima by Granzow, in the manner suggested by the examiner, would render Yashima unsatisfactory for its intended purpose, the appellant submits that there is no suggestion or motivation to make the proposed modification. We agree.

In our view, the only suggestion for modifying Yashima in the manner proposed by the examiner stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

On page 13 of the answer, the examiner asserts that claims 1, 19 and 44 are each directed to an apparatus and the differences that the appellant is relying on to establish patentability lie in the intended use statements of the apparatus. The examiner then states that:

While the functional limitation[s] were considered during examination numerous case law citations as noted in MPEP 2114 refer to the necessity of apparatus claims being structurally rather than functionally distinguished from the prior art (i.e. citing a new use of a prior art apparatus does not result in patentability of an apparatus claim).

In our view, this position of the examiner is contrary to the position taken by the examiner in the rejections before us in this appeal. In any event, the functional limitations recited in claims 1, 19 and 44 do not merely state a purpose or intended use for the claimed structure but rather give "life and meaning" and provide further positive limitations to the invention claimed.

For the reasons set forth above, the decision of the examiner to reject claims 1, 19, 30 and 44, and claims 2 to 18, 21 to 29 and 31 to 44 dependent thereon, under 35 U.S.C. § 103 is reversed.<sup>2</sup>

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<sup>2</sup>We have also reviewed the patents to Logan, Asakawa and Chapin additionally applied in the rejection of claims 7, 15 to 17, 29 and 34 but find nothing therein that would have made it obvious at the time the invention was made to a person having

(continued...)

### REMAND

We remand this application to the examiner to consider if any pending claim is anticipated<sup>3</sup> by the embodiment of Granzow depicted in Figure 7. Specifically, the examiner should determine, on the record, whether or not the claimed "print media" is readable on Granzow's print transfer cylinder 122.

### CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 19 and 21 to 44 under 35 U.S.C. § 103 is reversed. In addition, this application has been remanded to the examiner for further consideration.

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<sup>2</sup>(...continued)  
ordinary skill in the art to have modified Yashima to arrive at the claimed subject matter.

<sup>3</sup>A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

REVERSED; REMANDED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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